

REMARKS

Claims 1-12 are pending. By this Amendment, the specification has been amended to indicate the correct the number of devices of each of the five types set forth in the paragraph in issue which were fabricated. No new matter is involved. The number of devices actually fabricated does not affect the subject matter being disclosed and claimed, so the proposed Amendment does not constitute new matter. The proposed Amendment provides correct information regarding the number of devices fabricated. Also, by this Amendment, claims 1-12 have been amended to address the Examiner's concern about zero overlap. No new matter is involved.

The Office Action rejects claims 1-12 under 35 USC §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

The basis of the rejection is that the recitation of "... is smaller than 0.3 μm " is indefinite allegedly because that range includes zero, which would effectively remove the limitation.

Applicants respectfully disagree with this conclusion.

All claims positively recite that at least one electrode layer "overlaps the one of the surfaces of the magnetoresistive element." An "overlap" has to have some dimension other than zero or it does not comprise an overlap. Thus, all claims recite an overlap of some finite dimension other than zero.

Applicants respectfully submit that this is clear to one of ordinary skill in the art, to which the disclosure is directed.

Nevertheless, to expedite prosecution, Applicants have amended the claims to recite that the overlap is "greater than zero", a feature which is inherently already recited in the claims.

Applicants respectfully submit that this Amendment does not narrow the scope of the claims in any way because it merely positively recites an already existing inherent feature of the claims.

Accordingly, the rejection of claims 1-12 under 35 USC §112, second paragraph should be withdrawn.

The Office Action rejects claims 1-12 under 35 USC §102(a) as unpatentable over European Patent EP 1117091 to Shoji. This rejection is respectfully traversed.

The effective date of Shoji, which is its publication date, is July 18, 2001. Applicants claim priority of two Japanese priority Applications, i.e., JP 2000-237366 and JP 2001-213453. The filing date of each of these priority applications is prior to the July 18, 2001 effective date of Shoji, and the claimed invention is described in at least one of those two priority applications. Applicants are providing herewith, as attachments, accurate translations of both of these priority documents. Certified copies of both applications have been filed and are acknowledged in the August 13, 2003 Office Action on the Office Action Summary page (PTO-326). The certified copies of these applications, along with the accurate translations thereof, comply with the requirements of 35 USC §119(b)(3). Accordingly, the Shoji reference has been removed as a prior art reference.

Support for the claimed features is found, for example, throughout both priority applications.

The '366 priority application appears to be very similar to the instant U.S. application, the main difference apparently being the fact that the '366 application has 21 figures, whereas the instant U.S. Application has 24 figures. The three added figures, i.e., Figs. 14-16 in the instant U.S. Application, compare a device according to the invention (type B device) with three other devices (types A, C and D). The three added figures are explained in the U.S. Application from page 27, line 6 through page 31, line 5. That description is not found in the

'366 application. However, the '366 application fully supports the claimed invention, the comparative data shown in Figs. 14 and 16 of the instant U.S. Application not being needed to provide support for the claimed invention. For example, the "greater than zero and less than 0.3 μm " feature is found throughout the '366 application including, for example, in paragraphs [0020] and [0021].

The '543 application contains the same 24 figures that are disclosed in the instant U.S. Application, and appears to contain the same specification. Accordingly, the '543 application provides support for the claimed invention. For example, the "greater than zero and less than 0.3 μm " feature is found throughout the '543 application including, for example, in paragraphs [0022] and [0023].

Applicants respectfully submit Shoji is not prior art with respect to the subject matter of claims 1-12, and therefore the subject matter of claims 1-12 is patentable, over Shoji. Accordingly, the rejection of claims 1-12 as anticipated by Shoji is improper and should be withdrawn.

Should the Examiner believe that there is anything further that is desirable to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:RJW/sxb

Enclosures:

English language translations of JP 2000-237366 and JP 2001-213543

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